

REMARKS

Reconsideration of the present application, as amended, is respectfully requested.

Claims 1-19 are pending in the Application, of which Claims 1, 5, 10, 18 and 19 are in independent form. Claims 1-12 and 16-17 are original, and Claims 18 and 19 have been newly added above. Claims 13-15 have each been amended above to correct a typographical error.

Turning to the Office Action, Claims 1-17 were rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,591,365 to Cookson in view of U.S. Patent No. 6,081,897 to Bersson and further in view of U.S. Patent No. 5,930,209 to Spitzenberger. (Office Action, ¶¶ 3-20)

Focusing initially on the rejection of independent Claim 1, paragraph 4 of the Office Action states (among other things) that Cookson discloses decoding of a watermark and determining if the fragile watermark has been tampered with. The Office Action also states that "Bersson discloses embedding copy protection information into copy control field of each track so that copyrighted tracks can be protected", and then states that "[i]t would have been obvious ... to place the watermark within the

control field of each track...". (Office Action, ¶4, lines 9-10 and 12-13) The Spitzenberger reference is cited in paragraph 4 of the Office Action for the sequence ID aspects of Claim 1.¹

The Office Action fails to show all of the recitations of Claim 1 in its rejection of Claim 1 based on Cookson, Bersson and Spitzenberger. The Office Action fails to show at least the Claim 1 recitation of "determining if at least one reserved bit is marked in the watermark in each of the first and last sections of the track".

This step of "determining if at least one reserved bit is marked in the watermark in each of the first and last sections of the track" is an important aspect of the Claim 1 method for determining the authorization of the rendering of a digital recording. For example, as described in the exemplary embodiment at p. 14 (line 17) to p. 15 (line 12) of the specification, such a feature may be used in preventing the piecing together of track sections improperly masked as separate tracks. As noted, the combination as set forth in the Office Action simply places the

¹ The Office Action also appears to state that Spitzenberger teaches "copy control information, such as watermark, can be placed in the lead-in or lead-out section". (Office Action, ¶4, lines 25-26) There is no explanation as to how this statement might be relevant in the rejection of the claims.

watermark described in col. 4 (lines 35-54) of Cookson in the track's control field. The Office Action thus fails to provide the Claim 1 recitation of "determining if at least one reserved bit is marked in the watermark in each of the first and last sections of the track".

According to MPEP 2142, the Examiner must initially provide a prima facie case of obviousness. One requirement for establishing a prima facie case under MPEP 2142 and 2143.03 is that the Examiner show all claim limitations are taught or suggested in the prior art. Without conceding any of the other issues pertaining to obviousness (such as the basis for combining references, or whether it would be reasonably successful), Cookson in view of Bersson and further in view of Spitzenberger as set forth in the Office Action fails to provide at least the above-noted recitation of Claim 1. For at least this reason, the Office Action fails to present a prima facie case of obviousness with respect to Claim 1 under MPEP 2143.03. Thus Claim 1 is allowable and allowance is respectfully requested.

Independent Claims 5 and 10 were rejected relying upon the same reasoning as for Claim 1.² (Office Action, ¶¶ 8 & 13) Applicant traverses the rejections of Claims 5 and 10 based at least upon analogous reasoning as that made for Claim 1 above. Allowance of Claims 5 and 10 is respectfully requested. Without conceding the patentability per se of the dependent claims, dependent Claims 2-4, 6-9 and 11-17 are allowable at least by virtue of their dependency on their respective independent claim.

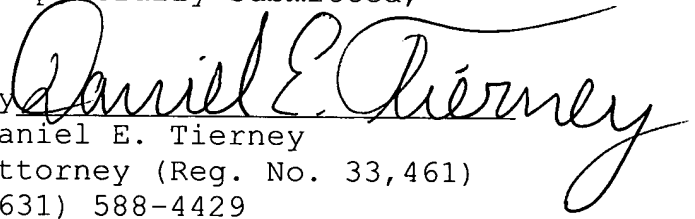
Finally, new independent Claim 18 recites, among other things, "determining if at least one reserved bit is marked in the watermark in the first section of the track". New independent Claim 19 recites, among other things, "the reserved bit being marked in the watermark data corresponding to the first track section". These recitations are not shown in the combination of Cookson, Bersson and Spitzenberger as set forth in the Office Action. For at least this reason (and without conceding any of the other issues pertaining to obviousness), the combination of Cookson, Bersson and Spitzenberger as set forth in the Office

² The Office Action states in paragraphs 8 and 13 that Claims 5 and 10 both "encompass the same scope as Claim 1". Applicant interprets the Examiner's wording in this regard as being informal. Claims 1, 5 and 10 have differences and thus, strictly speaking, as a general proposition they do not have the "same" scope.

Action fails to present a prima facie case of obviousness with respect to Claims 18 and 19 under MPEP 2143.03. Consideration and allowance of Claims 18 and 19 is respectfully requested.

In view of the above, it is respectfully submitted that all claims of the application, namely Claims 1-19, are in condition for allowance. Allowance is respectfully requested. Should the Examiner believe that a telephone conference would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,

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